

Remarks

The office action dated august 28, 2006 has been received and its contents carefully noted. In response thereto Applicant has amended the specification and claims as set forth above in an effort to place the application in condition for allowance. Applicant respectfully solicits such action at an early date and offers the following cogent reasoning in support thereof.

Information Disclosure Statement

The Examiner has indicated that the references identified in the IDS submitted on February 9, 2006 have been considered and made of record. Applicant notes that several of the references mentioned in the IDS have been crossed out and requests clarification if these references also have been considered and if not, what the reasoning is for not considering them.

Specification Objections

In Section 6b of the office action, the Examiner has argued that "the network" does not have antecedent basis in the second paragraph on page 7. Applicant respectfully submits that one skilled in the art clearly understands that the disabling SMS message is sent to the cellular communications network in which the mobile telephone is communicating. Reference may be had to Figure 1, showing the components of a cellular mobile telephone 2 for operation in a cellular communication network and the description page 4, line 27 to page 5, line 11; page 6, line 29 to page 7, line1; and to Figure 3 showing a cellular communications network and the corresponding description at page 7, lines 2 to 16. Sending and receiving an SMS message and the understanding of SMS communication in a cellular network is inherent in the operation of a communication network such as described and contemplated in the specification. If this were not the case, there would be no way to have the disabling SMS message communicate to the cellular communications network in which the mobile telephone is communicating in such that the mobile telephone could be rendered inoperative as a normal telephone.

Applicant submits that there is sufficient antecedent basis for the "message sent to the network", however in an effort to place the application in condition for allowance, the specification at page 7, second paragraph has been amended as set forth above to clearly recite

the SMS message is sent to the cellular communications network in which the mobile telephone 2 communicates. There is full support for the amendment to the specification as found in the drawings and specification and also thorough the inherent operation of a cellular communications network as well understood by those skilled in the art. No new matter is added or issues presented by way of the amendment. Applicant respectfully requests withdrawal of the objection to the specification.

Claim Objections

Applicant has amended claims 41-46, 49-53, 55-58, 60-62 and 64-66 as set forth above to overcome the Examiner's objection to these claims and respectfully requests withdrawal of the objections.

Claim Rejections

In Section 8a of the office action, the Examiner has stated that the term "radio frequency wireless couple" in former claims 54 and 59 is not clearly described in the specification and constitutes added matter. Applicant has amended claims 54 and 59 to recite "a radio link between (a) device and (a) counterpart device" rather than a "radio frequency wireless couple" to overcome the rejection. Page 6, lines 4 to 8 of the specification provide clear support for this claim amendment. No new matter or issues for consideration are presented by way of the amendment. Applicant requests withdrawal of the rejection.

The Examiner has also stated in Section 8b of the office action that the term "partial disablement" in claims 54, 56, 57 - 59 and 61 - 63 is not clearly described in the specification and constitutes added matter. However, it is seen at page 2, lines 16 - 17 and page 2, line 31 to page 3, line 2 clearly refer to the term "partial disablement". Therefore, the limitation is clearly described in the originally filed specification and provides support for the limitation. Applicant requests withdrawal of the rejection of these claims and likewise for similar reasoning requests withdrawal of the objection to the specification raised in Section 6a of the office action.

New dependent claims 67 and 68 have been added as set forth above. These claims further define the term "partial disablement". Claim 67 depends from claim 54 and recites the claim limitation "when the device is partially disabled it is only capable of restricted use". Claim 68 depends from claim 59 and recites the claim limitation "when the device is partially disabled it

is only capable of restricted use". New dependent claims 67 and 68 are supported at page 2, lines 16 - 17 and from page 2, line 31 to page 3, line 2. No new matter or issues for consideration are presented by way of the new claims 67 and 68.

In Section 10 of the office action, the Examiner has rejected independent claims 54, 59 and 63 under 35 U.S.C. §102(b) as being completely anticipated by Sasakura et al. (US Patent No. 6,151,493).

In Sasakura, the owner of a cellular phone 30 wears a transmission unit 10. The transmission unit 10 sends a signal to the phone 30 to keep it in operation. When the phone 30 is more than a predetermined distance from the transmission unit 10, and the strength of the signal sent by the transmission unit 10 drops below a threshold level, the phone 30 is disabled using the canceling unit 20 and the AND gate 36a in the phone 30 (see column 4, lines 14 to 28).

The canceling unit 20 provides an input to AND gate 36a. If the signal presence determination unit 22b in the canceling unit 20 determines that no ID signal is being received from the transmission unit 10, it outputs a signal to stop a signal generator 26 from producing a use prohibition canceling signal to the AND gate 36a. It appears that if this canceling signal is not sent from the signal generator 26 to the AND gate 36a via the switch 37c, the user will be unable to use the number and function keys 37a. Therefore, if a signal is not received from a transmission unit 10, the cellular phone 30 is completely disabled.

Independent claim 54 recites that a device comprises "a controller arranged to effect partial disablement of (a) device in response to authorized separation of the device and (a) counterpart device". This feature and claim limitation is clearly not disclosed in Sasakura, because in Sasakura the inability to use the number and function keys 37a means that the cellular phone 30 is completely disabled and not "partially disabled".

Furthermore, it is unclear how a person skilled in the art would adapt the disclosures of Sasakura to develop anything that would fall within the scope of the claim, particularly as when the phone in Sasakura is disabled, the number and function keys are completely inoperable.

As indicated in the paragraph page 2, line 26 to page 3, line 2 of the specification, the partial disablement of the telephone results in the telephone not being capable of normal use. However, advantageously, when the telephone is partially disabled it may only be capable of making emergency calls. Partial disablement of the telephone may also allow the telephone to make calls to a network operator call center and/or redirect restricted calls to/from the telephone to a network operator call center.

Applicant respectfully submits Sasakura fails to teach, disclose or suggest these claim limitations of independent claim 54 for at least the above reasoning and therefore requests withdrawal of the rejection under 35 U.S.C. §102(b).

The Examiner has treated independent claim 59 in the same way as independent claim 54 in Section 10 of the office action. However, independent claim 59 is of a different scope than independent claim 54, and is considered separately. Independent claim 59 recites:

"(a) device wearable by a person comprising:
a detector arranged to detect the unauthorized separation of the device from a counterpart device by detecting the diminution of a radio link between the device and the counterpart device; and a controller arranged to effect partial disablement of the counterpart device in response to the unauthorized separation of the device and counterpart device, by controlling a transceiver to transmit a radio command to the counterpart device".

Independent claim 59 is relevant to the embodiments of the invention described in the specification in which the "device" referred to in the claim may be, for example, a wrist watch and the "counterpart device" is a mobile telephone. A detailed description of these embodiments for example, is found at the first paragraph on page 6 of the specification. Independent claim 59 recites that a controller of the device (e.g. a wrist watch) is arranged to effect partial disablement of a counterpart device (e.g. a mobile telephone) in response to the unauthorized separation of the device and the counterpart device by controlling a transceiver to transmit a radio command to the counterpart device.

There is no disclosure in Sasakura of any device commanding the partial disablement of another device, and in particular, there is no disclosure of a "radio command" being sent to another device in order to partially disable a device. Sasakura merely discloses that a signal presence termination unit 22b in a canceling unit 20 of a cellular phone 30 determines whether or not a signal is being received from a transmission unit 10. The cellular phone 30 therefore controls its own disablement.

Applicant respectfully submits that independent claim 59 likewise presents limitations similar to those of independent claim 54 and further for limitations not found in independent claim 54. Independent claim 59 is not anticipated as being completely shown under 35 U.S.C. §102(b) for similar reasoning as set forth above with respect to independent claim 54 and for the further reasoning set forth above with respect to the discussion of independent claim 59. Applicant requests withdrawal of this rejection for at least the above reasoning.

Applicant respectfully submits that independent claim 63 likewise presents limitations similar to those of independent claim 54 and independent claim 59 and is likewise not anticipated under 35 U.S.C. §102(b) for similar reasoning as set forth above with respect to independent claims 54 and 59. Applicant submits similar reasoning applies to independent claim 63 and requests withdrawal of this rejection for at least the same reasoning.

In Section 14 of the office action, the Examiner has rejected claim 65 and 66 under 35 U.S.C. § 103(a) as being unpatentable over Sasakura in view of Decotignie (US Patent Publication 2001/0016484).

Dependent claim 65 depends from independent claim 54 which claim distinguishes over Sasakura as set forth above. Dependent claim 65 sets forth the further limitation and recites that "the device is a mobile telephone that is operable to make emergency calls when it is partially disabled".

Dependent claim 66 depends from independent claim 59 which claim distinguishes over Sasakura as set forth above. Dependent claim 66 sets forth the further limitation and recites that "the device is a mobile telephone that is operable to make emergency calls when it is partially disabled".

Decotignie discloses a mobile telephony device intended for accommodating a user identification module. If an identification module is placed inside the device and which module is not the one that is linked to the device, the device goes into a first blocking state in which "it can no longer receive an incoming call nor transmit an outgoing call (possibly with the exception of emergency numbers)" (paragraph (0027), page 2).

However, it is clear that the teachings of Sasakura are completely incompatible with the teachings of Decotignie. Disablement of the cellular phone 30 in Sasakura results in the number and function keys 37a of the cellular phone 30 being completely disabled. It is therefore unclear how a person skilled in the art would adapt the cellular phone 30 of Sasakura so that it is capable of making calls to emergency numbers. The intention of Sasakura is clearly to completely disable the device, so that no calls can be made.

The combination of the teachings of Decotignie with Sasakura as suggested by the Examiner does not overcome the fundamental deficiencies of Sasakura nor does the combination teach, disclose or suggest applicant's invention as disclosed and claimed. Applicant respectfully requests withdrawal of the rejection of dependent claims 65 and 66 for at least the reasoning set forth above with respect to Sasakura and Decotignie.

In Section 11 of the office action, the Examiner has rejected independent claims 40 and 48 as being unpatentable over Sasakura in view of Pons et al (US Patent No. 5,345,221).

Pons discloses "a personal alarm system 10 having a plurality of identical modules 12, 12a in a paired opposed relationship" (column 4, lines 57 to 59). An aperture in the first module 12 is adapted to receive the first end 66 of a lanyard 68. The lanyard 68 has a second end 70 adapted for coupling the module 12 to a person, or in an alternative embodiment to a fixture" (column 6, lines 1 to 5).

A leash 72 has a first end 74 attached to the aperture 60a in the lug 62a of the paired, opposed module 12a. The leash 72 has a second end 76 adapted for removable attachment to (a) valuable item, such as a pet a purse, a briefcase or the like" (column 6, lines 6 to 10).

"When the armed modules 12 and 12a are separated due a thief pulling the valuable item from (a) person or dropping (a) briefcase or the like, the electrical circuit 30 in each module 12 is activated when (a) switch magnet 54a is removed from an effective range of about half inch from (a) reed switch 52 in the opposite module 12. At this point (an) audible noise of about 100 to 120 decibels is generated for each siren transducer 32 thereby alerting law enforcement personnel and passersby to a robbery or an attack taking place" (column 6, line 58 to column 7, line 2).

Neither Pons nor Sasakura disclose "control means arranged to effect at least partial disablement of the device in response to the release of (a) releasable connector" as required by attached claim 40. No combination of Pons and Sasakura can therefore result in anything that would fall within the scope of independent claim 40.

Furthermore, Pons is concerned with the enablement of a device (an alarm device) in order to alert people that something may have been stolen, not the disablement of any device.

Sasakura discusses prior systems in which if the user of a cell phone unknowingly leaves his phone behind or has it stolen, the phone is disabled automatically. It points out that these systems have no alarm means for notifying the user of the fact that his phone had been left behind or stolen, and therefore the user may not notice that he has lost his phone. The object of Sasakura is therefore "to provide a use prohibition system which can disable a cellular phone or any other object if it separates more than a predetermined distance from the user, and at the same time give a warning to the user" (column 2, lines 19 to 24). There would be no motivation for a person skilled in the art to combine the disclosures of Sasakura and Pons in order to include a second alarm system, as the second alarm system would be redundant.

Applicant submits the combination of Sasakura and Pons does not teach, disclose or suggest applicant's invention for at least the above reasons.

Independent claim 48 is also believed to be novel and non-obvious for the same reasons as those given in relation to independent claim 40. Applicant respectfully requests the withdrawal of the rejection.

Dependent claim 45 depends indirectly to independent claim 40 and recites that the control means of the device "is arranged to effect at least partial disablement of the device by controlling (a) cellular and radio transceiver to transmit a disable message instructing the at least partial disablement of the device".

The Examiner has rejected dependent claim 45 as being unpatentable over Sasakura in view of Pons. However, Sasakura merely discloses disabling a device by disabling the number and function keys of a device. It does not refer to "controlling a cellular radio transceiver to transmit a disable message instructing the at least partial disablement of the device" as required by dependent claim 45. Applicant respectfully requests withdrawal of the rejection for at least this reason.

In Section 14 of the office action, the Examiner has rejected dependent claim 46 as being unpatentable over Sasakura in view of Pons and in further view of Rohrbach (US Patent No. 5,898,783). Dependent claim 46 refers to effecting "at least partial disablement of (a) device by sending a disabling message to (a) network instructing the network to disable normal operation of the telephone in the network".

Rohrbach discloses a SIM card 110 comprising data communication circuitry 200, logic circuitry 210 and disabling circuitry 220. Data communication circuitry 200 is operative to transmit a code identifying the SIM card 110, from logic circuitry 210 within the card, to a telecommunications network via a mobile station 100. The telecommunications network searches a disable database and returns a disable command if the unit code identifying the SIM card 110 is found in the disable database. In response to receiving a disable command, the disabling circuitry 220 is operative to incapacitate the logic circuitry 210 to prevent or limit further operation of the SIM card thereby being incapacitated with respect to the telecommunications network and systems independent of telecommunications network (see column 4, lines 13 to 25).

In Rohrbach, a message sent from the SIM card 110 to the network via the mobile station 100, which message merely identifies the SIM card 110 in the mobile station 100. The message does not explicitly instruct the network to disable the SIM card. The SIM card 110 is only disabled if the unique code identifying the SIM card 110 is found in the disable database. The

decision to disable the SIM card is therefore made at the network, rather than at the SIM card 110 or the mobile station 100.

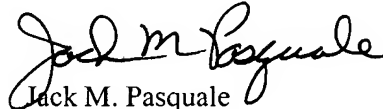
The message disclosed in Rohrbach cannot therefore be considered to be "a disable message instructing the at least partial disablement of the device" as required by dependent claim 46. Dependent claims 53, 56, 58 and 61 are thought to be novel and non-obvious for the same reasons as those given in relation to dependent claim 46. Applicant respectfully requests withdrawal of the rejection of these claims.

Conclusion

Applicant submits that all the claims of the application are now in condition for allowance and earnestly solicits such action at an early date. The Examiner is invited to call applicant's attorney if any questions remain following review of this response.

Respectfully submitted,

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